Remarks

Claims 1, 3-8, 10-18, 20-25 and 27-46 are pending in the application. Claims 1-42 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Von Kohorn (U.S. Pat. No. 5,916,024). In view of the following remarks, reconsideration and withdrawal of the rejection is requested. Claims 2, 9, 19 and 26 have been cancelled. Claims 43-46 are new.

As a preliminary matter, it is noted that Von Kohorn describes numerous distinct embodiments throughout 163 columns of text and 48 figures. There is no teaching or suggestion to use all of the elements of the various embodiments together in a single implementation. In fact, several of the embodiments include components that are not useable together. For example, although many different response units are described (e.g., response unit 22 at column 21, lines 49-57; response unit 210 at column 40, line 35 – column 41, line 25; response unit 800 at column 79, lines 46-61; and response unit 1414 at column 140, lines 23-45), any implementation of the Von Kohorn system would likely use only one form of response unit.

The passages selected from Von Kohorn and cited in the Office Action to allegedly show all of the elements of the claims are scattered throughout the reference and relate to several of the different embodiments. It is well settled that "an anticipation is not established if in reading a claim on something disclosed in a reference it is necessary to pick, choose and combine various portions of the disclosure not directly related to each other by the teachings of the reference." *Ex parte Beuther*, 71 USPQ2d 1313, 1316 (Bd. Pat. App. & Int. 2003) (citing *In re Arkley*, 172 USPQ 524, 526 (CCPA 1972)).

The Applicant respectfully contends that a fair reading of Von Kohorn reveals no teaching or suggestion to combine all of the passages cited in the Office Action into a single implementation of a game. The accompanying Declaration of Steen Kanter confirms that one skilled in the art, after reading Von Kohorn, would not be motivated to combine the elements of the various embodiments into a single implementation. (Kanter Dec. at ¶ 24.) If the present rejection is to be maintained, it is requested that an explanation be provided as to how Von Kohorn suggests the use of the various elements from different embodiments in a single implementation.

However, notwithstanding the foregoing, the Applicant respectfully contends that the present rejection cannot be maintained because Von Kohorn does not describe or suggest all of

the elements of the claims. In addition to the reason noted above, the Declaration of Mr. Kanter is submitted as evidence that one skilled in the art would not read Von Kohorn as describing or fairly suggesting all of the elements of the claims. Mr. Kanter's Declaration is relevant to the present rejections under 35 U.S.C. § 102, and also demonstrates that the claimed invention is not obvious over Von Kohorn.

VON KOHORN DOES NOT DESCRIBE OR SUGGEST ADVERTISING IMAGES AS ACTIVE GAME ELEMENTS

Claim 1 has been amended to recite that the additional advertising image is an active element of the game. Support for the amendment can be found in the specification in paragraph 0021 and in original dependent claims 2, 9, 19 and 26. Similar amendments have been made with respect to independent claims 8, 18, 25, 32 and 42. As defined in paragraph 0021, an active game element is an element that the player must actively use, such as by clicking on the image to select an answer or make a move. The distinction between an active game element and a non-active element is exemplified in Figure 7C, which includes examples of both active and non-active game elements. Active game elements include Coke® and Dr. Pepper® tic-tac-toe game pieces. Non-active elements include advertisements for Sports Authority and Victoria's Secret. The player must use the tic-tac-toe pieces to play the game, while the Sports Authority and Victoria's Secret advertisements are merely observed by the player. The fact that the player must actively use the image to play the game is what makes it "active". In order to further reinforce this point, new dependent claim 43 affirmatively recites that the player must click on the active game element to select an answer or make a move. New claims 44-46 also relate to active game elements.

Although Von Kohorn may contemplate the use of an advertised item in a trivia game, Von Kohorn does not describe or suggest that the item be used as an active game element. Instead, Von Kohorn merely indicates that the item is shown to the player with the hope that the player will then answer a question about it. (*See*, col. 47, lines 1-15.) In the case of Von Kohorn, the player passively observes the item, similar to the Sports Authority and Victoria's Secret advertisement in Figure 7C. In Von Kohorn, the player may answer questions about the advertised item, but does not place the image on the screen (like a tic-tac-toe piece), click on the

image, or otherwise actively use it in any way. Thus, Von Kohorn does not describe or suggest incorporating an advertising image as an active game element (as recited in claims 1, 8, 18, 25, 32 and 42), and certainly does not suggest that the player must click on the image (as recited in new claims 43 and 45), use the image as a game piece (as recited in new claim 46), or otherwise use them as active game elements (as recited in new claim 44).

In fact, Von Kohorn cannot describe or suggest using an advertising image as an active game element. As has been explained at length in response to previous Office Actions, Von Kohorn principally contemplates a system in which the players respond to questions or images that have been broadcast from a central studio. The questions and images are observed by the players on a television screen. The players' responses, on the other hand, are entered into a distinct "response unit", identified by reference numerals 22 or 210. The Applicant has carefully studied the passages cited in the Office Action in connection with the rejection of claim 2, which originally included the recitation of an active game element. The advertising images described in those passages are limited to that broadcast from the studio. The passages include no indication that the response unit includes an advertising image in any form. Because the players' active participation in the game is limited to the response unit, the advertised items of Von Kohorn cannot possibly be actively used by the players.

The Applicant notes that subsequent passages of Von Kohorn describe embodiments with "smarter" response unit, such as response unit 800, which includes a computer, and response unit 1414, which can be part of or used in conjunction with a game machine. However, the "smarter" response units appear to perform substantially the same function as response units 22 and 210. The embodiments having "smarter" response units can interject advertising messages into a game playing scenario by interrupting operation of the game playing, by superposition of the advertising message, or by presenting the message in a split screen or window. (See col. 153, lines 18-26.) In short, none of the embodiments of Von Kohorn include any disclosure or suggestion that an advertising image be included as an active element of a game. The Declaration of Mr. Kanter confirms that one skilled in the art, after reading Von Kohorn, would not find any description or suggestion in the reference to incorporate advertising images into an interactive game as active game elements. (Kanter Decl. ¶ 22.) For at least these reasons, claims 1, 8, 18, 25, 32, 42 and their dependent claims are patentable over Von Kohorn.

New claim 44 is similar to claim 1 as it was originally filed and also recites the step of

requiring the one or more players to actively use the advertising images as active game elements to play the interactive game. Dependent claims 45 and 46 further define the players' active use of the advertising images, respectively, as clicking on the advertising images and as using the advertising images as game pieces. Support for the new claims can be found, for example, in paragraphs 0021, 0038 and in the Figures. For the reasons set forth above, claims 44-46 are also patentable over Von Kohorn.

VON KOHORN DOES NOT DESCRIBE OR SUGGEST TAILORING ADVERTISING CONTENT BASED ON PLAYER'S PERSONAL INFORMATION

As noted in response to the last Office Acton, claims 6, 14, 23, 30 and 36 also recite elements which are neither disclosed nor suggested by Von Kohorn. Each of these claims recites elements regarding the compiling of a player's personal information, and the using of such information to tailor advertising content of the interactive game for the particular user. For instance, the method may involve asking the user for their name, age and favorite sport. If the user responds that "basketball" is their favorite sport, the advertising content presented during the interactive game may relate to Nike® basketball sneakers, or the like.

It is indicated in the Office Action that column 137, lines 40-67 of Von Kohorn disclose compiling demographic information and targeting advertisements based on the information. The Applicant agrees that the passage describes the collection of demographic information, but respectfully contends that it does not describe or suggest using the information to target advertising. According to Von Kohorn, two sets of criteria are polled. The first set is used exclusively to filter out inappropriate responses and to disqualify player candidates based on negative criteria, such as if the candidate has not completed high school. The second set of criteria includes demographic information that is used to limit respondents to those of a desired group and to identify discrete segments of the polled population for additional polling. The data gathered by the polling can then be analyzed, otherwise processed and made available to the sponsor. The passage further states that the software designed in connection with the polling allows for the flexibility of individually programming circuitry to achieve the stated objectives. As explained in the Declaration of Mr. Kanter (*see*, Kanter Dec. ¶ 23), this means that the polling software can be configured to collect and analyze data. The passage includes no description or

suggestion to use the polled data to target advertising material in an interactive game based on player information.

As previously noted, the Examiner also cites five (5) continuous pages of Von Kohorn (i.e., col. 1, line 25 to col. 10, line 43) to support rejection of claims 6, 14, 23, 30 and 36. It is again respectfully pointed out, however, that the Applicant can find no specific teaching or suggestion of the compilation and use of personal information to tailor advertising content in an interactive game in these portions of the reference. Accordingly, it is contended that Von Kohorn, as a whole, includes no description or suggestion of the element in question. For at least these reasons, reconsideration and withdrawal of the rejection of claims 6, 14, 23, 30, 36 and their dependent claims is also respectfully requested.

THE ELEMENTS MISSING FROM VON KOHORN WOULD NOT HAVE BEEN OBVIOUS

The Applicant acknowledges that the issue of obviousness is not directly at issue because the present rejections are based on 35 U.S.C. § 102. However, objective evidence of non-obviousness is being submitted herewith in the form of a Declaration of Steen Kanter under 37 C.F.R. § 1.132. This evidence is being submitted to avoid any subsequent rejection based on 35 U.S.C. § 103, should it be the Examiner's position that the elements missing from Von Kohorn are merely obvious.

The objective evidence of non-obviousness submitted herewith relates to several secondary considerations explained in *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). Secondary considerations applicable to the present invention include the commercial success actually enjoyed by the invention, initial skepticism of those in the field, copying by another and the fulfillment of a long felt need in the art.

Mr. Kanter is the founder and CEO of a highly regarded marketing and business consulting firm. He has thirty years of experience in executive positions with companies that sell what are now instantly recognizable brands. Mr. Kanter is experienced in the field of advertising, and skilled in the art to which the present invention relates.

As set forth in more detail in the Declaration of Mr. Kanter, the invention, as claimed in the application, was embodied in an interactive game of Concentration that was actively used on

the website of Tommy Hilfiger for a three-month test period. (Kanter Decl. ¶¶ 7-10.) During the trial period, the game was played approximately 87,000 times by website visitors, attracted many new visitors to the Hilfiger website and, by virtue of a sign-up screen that collected demographic information, provided Hilfiger with valuable new marketing information. (Kanter Decl. ¶¶ 10-12.) The game enjoyed commercial success by any reasonable standard. (Kanter Decl. ¶¶ 12.)

Following the trial period, Hilfiger removed the game from its website. (Kanter Decl. ¶ 13.) The game was replaced by another Concentration game, which Hilfiger's own website designer created by copying the Applicant's Concentration game. (Kanter Decl. ¶ 14.) The copied game was substantially similar to the Applicant's Concentration game in its screen displays, animation and functionality, and performed all of the steps of the claimed invention. (Kanter Decl. ¶¶ 14-15.) The copied version of the Concentration game represents the act of copying by another, and further demonstrates that Hilfiger viewed the invention as representing a significant improvement over conventional Internet advertising and an inventive leap forward over the prior art.

Prior to the trial period, executives at Tommy Hilfiger were skeptical that the Concentration game would be successful. (Kanter Decl. ¶ 17.) The actual commercial success of the game during the trial period and the effort that Hilfiger expended in subsequently copying the game demonstrate that the initial skepticism was unfounded. (Kanter Decl. ¶ 18.)

The invention solved a long felt need in the field of Internet advertising. Internet users are typically unaccepting of conventional forms of Internet advertising. (Kanter Decl. ¶ 19.) However, by incorporating advertising images into an interactive game as active elements of the game, and by tailoring the advertising images to the individual user's interests, the invention encourages players to accept advertising content, and, in fact, embrace it. The advertising images, therefore, can be dynamic elements of the game that the user actively manipulates. Thus, the invention has solved a long felt need in the art to make advertising content acceptable to Internet users. (Kanter Decl. ¶¶ 19-20.)

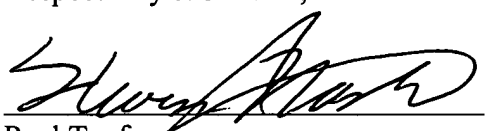
Thus (and as explained more fully in the Declaration of Mr. Kanter), the present invention has solved a long felt need in the art to make Internet advertising acceptable to Internet users. The manner in which the invention did so was non-obvious to those in the field, as evidenced by the skepticism of the Tommy Hilfiger executives prior to the test period. Despite this skepticism, the invention, when embodied in the original Concentration game, enjoyed

significant commercial success, and because of that success, has been copied by another. In summary, there exists significant objective evidence of non-obviousness with respect to the invention.

Summary

In view of the foregoing remarks, reconsideration and withdrawal of all of the objections and rejections are requested. The Applicant submits that this application is new and non-obvious over Von Kohorn, and is in condition for allowance, which action is earnestly solicited.

Respectfully submitted,



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